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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,925	08/10/2001	Koji Mizobuchi	01480/LH	6043

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EXAMINER

QUIETT, CARRAMAH J

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/927,925		MIZOBUCHI, KOJI	
	Examiner		Art Unit	
	Carramah J. Quiett		2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ⁰⁹ ~~26~~ May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/09/2006 has been entered.

Response to Amendment

2. The amendment(s), filed on 04/12/2006, have been entered and made of record. Claims 1-3 and 5-9 are pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

4. The indicated allowability of claim 6 is withdrawn due to alternative interpretation of this claim when applied to a previously cited reference. Rejections based on the previously cited reference follow.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1 and 8-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ejima et al. (U.S. Patent Application Pub. #2002/0021262) in view of Fukuta (U.S. Pat. #4,858,031).

As for **claim 1**, Ejima discloses a data recording and reproducing apparatus (figs. 1-6) having a function of reproducing audio data and image data associated with the audio data (page 1, paragraph 7), said apparatus comprising:

audio data reproducing means (fig. 2, ref. 7B) for reproducing audio data (page 2, paragraph 35); and

display means (figs. 2/9, ref. 6) for displaying, while the audio data reproducing means is reproducing the audio data (page 4, paragraph 60), first information (fig. 9, Audio Mark/Time) including character data (Audio Time) representing reproduction status of the audio data, (page 5, paragraph 75) and for displaying second information (fig. 9, Recording Date/Data Set Number) including image data (thumbnail image) associated with the audio data being reproduced (page 5, paragraph 75).

However, Ejima does not expressly disclose character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data.

In a similar field of endeavor, Fukuta discloses a display means (figs. 1, 2, and 6, ref. 24) for displaying first information (refs. 72-74) including character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data (col. 9, lines 42-58). Also, please read col. 8, lines 28-61. In light of the

teaching of Fukuta, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ejima's apparatus with a display means for displaying first information including character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data. This modification would allow a user to know the available time for audio reproduction in a readily understandable manner (Fukuta, col. 1, line 67 – col. 2, line 7).

As for **claim 8**, Ejima discloses a data recording and reproducing apparatus (figs. 1-6) having a function of recording audio data and image data associated with the audio data (page 1, paragraph 7), said apparatus comprising:

audio data reproducing means (fig. 2, ref. 7B) for reproducing audio data (page 2, paragraph 35); and

display means (figs. 2/9, ref. 6) for displaying, while the audio data reproducing means is reproducing the audio data (page 4, paragraph 60), first information (fig. 9, Audio Mark/Time) including character data (Audio Time) representing reproduction status of the audio data (page 5, paragraph 75) and for displaying second information (fig. 9, Recording Date/Data Set Number) including image data (thumbnail image) (page 5, paragraph 75).

However, Ejima does not expressly disclose character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data and image data associated with a time elapsed during recording of the audio data that the audio data reproducing means is reproducing.

In a similar field of endeavor, Fukuta discloses a display means (figs. 1, 2, and 6, ref. 24) for displaying first information (refs. 72-74) including character data representing at least an

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elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data (col. 9, lines 42-58). Also, please read col. 8, lines 28-61. In light of the teaching of Fukuta, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ejima's apparatus with a display means for displaying first information including character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data. This modification would allow a user to know the available time for audio reproduction in a readily understandable manner (Fukuta, col. 1, line 67 – col. 2, line 7).

Additionally, Examiner takes Official Notice that it is well known in the art to associate image data with a time elapsed during recording of the audio data that the audio data reproducing means is reproducing. This modification enhances the operativity of a small-sized image/audio recording device.

For **claim 9**, Ejima, as modified by Fukuta and the Official Notice, discloses the apparatus, wherein every time the time elapsed during the recording of the audio data is detected (Ejima – fig. 7; pages 4-5, paragraphs 65-69), the display means displays the image data for a predetermined time (Ejima – figs 8/9; page 5, paragraphs 73-75) and then displays the information of the reproduction status of the audio data (Ejima – figs 8/9; page 5, paragraphs 73-75; Fukuta – fig. 6; col. 9, lines 42-58). In fig. 7, Ejima teaches a process where audio data has been recorded in Steps S10-212. This process detects whether or not the preset time interval has elapsed after resetting the time and sensing the status of the audio button. Then, Ejima explains how this process stores and displays the image/audio data. As shown in fig. 9, data set number 2

displays image data for a preset time interval and then, the time as well as the duration of the audio data is displayed at data set number 3. Please read page 5, paragraphs 74-75.

7. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Patent Application Pub. #2002/0057351) in view of Fukuta (U.S. Pat. #4,858,031).

As for **claim 2**, Suzuki discloses a data recording and reproducing apparatus (figs. 1-4) comprising:

audio data reproducing means (fig.2/fig. 4, refs. 5 and 36) for reproducing selected audio data (page 2, paragraph 35; page 3, paragraph 57); and

display means (fig. 4, ref. 6) for displaying at least image data associated with the selected audio data (page 3, paragraph 56);

instruction means (fig. 2, ref. 7; fig. 4, refs. 6A/B, 34, 35, and 41) for instructing whether to display the image data (page 2, paragraphs 35-38) with the display means when the audio data reproducing means reproduces the audio data (fig. 5, paragraphs 84-89);

control means (fig. 11, 6B) for causing the display means to display data representing reproduction status of the audio data (pages 6-7, paragraphs 101, 103-105), when the instruction means instructs the display means not to display the image data (figs. 12, 13, and 15). When the pen selects sound effects via the setting mode, it is inherent that the pen instructs the display not to display the image data. As shown in fig. 15, the LCD displays audio data as a result of the setting selection from the pen.

However, Suzuki does not expressly disclose character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data.

In a similar field of endeavor, Fukuta discloses a control means (fig. 1, ref. 20/23) for causing the display means (figs. 1, 2, and 6, ref. 24) to display first information (refs. 72-74) including character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data (col. 9, lines 42-58). Also, please read col. 8, lines 28-61. In light of the teaching of Fukuta, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Suzuki's apparatus with a display means for displaying first information including character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data. This modification would allow a user to know the available time for audio reproduction in a readily understandable manner (Fukuta, col. 1, line 67 – col. 2, line 7).

8. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Patent Application Pub. #2002/0057351) in view of Fukuta (U.S. Pat. #4,858,031) as applied to claim 2 above, and further in view of Peng (U.S. Pat. #6,774,939).

For **claim 3**, Suzuki, as modified by Fukuta, discloses an apparatus, wherein the control means causes the display means to display the reproduction status of the audio data when the instruction means instructs the display means to display the image data (pages 6-7, paragraphs 101, 103-105). However, Suzuki and Fukuta do not expressly teach that the control means

causes the display means to display the reproduction status of the audio data after displaying the image data for a predetermined time.

In the same field of endeavor, Peng discloses an apparatus (figs. 1-3, ref. 100), wherein the control means (fig. 2, ref. 32, 36) causes the display means to display the reproduction status of the audio data after displaying the image data for a predetermined time. Please see fig. 11, and read col. 14, lines 34-44. In light of the teaching of Peng, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Suzuki's apparatus with a control means (fig. 2, ref. 32, 36) causes the display means to display the reproduction status of the audio data after displaying the image data for a predetermined time, when the instruction means instructs the display means to display the image data in order ^{to} provide a user with the option of capturing several image (or continuous image capture) at the same time as recording audio (Peng, col. 6, lines 50-53).

9. **Claims 5-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ejima et al. (U.S. Patent Application Pub. #2002/0021262) in view of Fukuta (U.S. Pat. #4,858,031) and Peng (U.S. Pat. #6,774,939).

As for **claim 5**, Ejima discloses a data recording and reproducing apparatus (figs. 1-6) capable of* reproducing audio data and image data associated with a part of the audio data (page 1, paragraph 7), said apparatus comprising:

display means (figs. 2/9, ref. 6) for displaying an operating status of the apparatus (pages 2, paragraphs 32-35) and

control means (fig. 6, refs. 6A, 7 and 39) for causing the display means (figs. 2/9, ref. 6) to display first information (fig. 9, Audio Mark/Time) including character data (Audio Time) representing a reproduction status of the audio data (page 5, paragraph 75) while the audio data is being reproduced (page 4, paragraph 60), and for displaying second information (fig. 9, Recording Date/Data Set Number) including the image data associated with said part of the audio data (page 5, paragraph 75), when said part of the audio data is reproduced. Additionally, he teaches that the audio data accompanying the image data was recorded in fig. 7 (page 5, paragraph 72). However, Ejima does not expressly disclose character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data and reproducing audio data and image data associated with that part of the audio data, which is recorded the moment the image data, is generated.

In a similar field of endeavor, Fukuta discloses a control means (fig. 1, ref. 20/23) for causing the display means (figs. 1, 2, and 6, ref. 24) to display first information (refs. 72-74) including character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data (col. 9, lines 42-58). Also, please read col. 8, lines 28-61. In light of the teaching of Fukuta, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ejima's apparatus with a display means for displaying first information including character data representing at least an elapsed reproduction time of the audio data being reproduced as information of a reproduction status of the audio data. This modification would allow a user to know the available time for audio reproduction in a readily understandable manner (Fukuta, col. 1, line 67 – col. 2, line 7).

Also, in the same field of endeavor, Peng discloses a data recording and reproducing apparatus (figs. 1-3, ref. 100) capable of reproducing audio data and image data associated with a part of the audio data (col. 7, lines 11-21) which is recorded at a moment when the image data is generated (col. 6, lines 50-53). In light of the teaching of Peng, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ejima's apparatus with audio data which is recorded the moment the image data is generated in order provide a user with the option of capturing several image (or continuous image capture) at the same time as recording audio (Peng, col. 6, lines 50-53).

For **claim 6**, Ejima, as modified by Fukuta and Peng, discloses the apparatus, wherein every time said part of the audio data is reproduced (Ejima – fig. 7; pages 4-5, paragraphs 65-69), said control means causes the display means to display the second information for a predetermined time (Ejima – figs 8/9; page 5, paragraphs 73-75) and then to display the first information upon lapse of the predetermined time (Ejima – figs 8/9; page 5, paragraphs 73-75; Fukuta – fig. 6; col. 9, lines 42-58). In fig. 7, Ejima teaches a process where audio data has been recorded in Steps S10-212. This process detects whether or not the preset time interval has elapsed after resetting the time and sensing the status of the audio button. Then, Ejima explains how this process stores and displays the image/audio data. As shown in fig. 9, data set number 2 displays image data for a preset time interval and then, the time as well as the duration of the audio data is displayed at data set number 3. Please read page 5, paragraphs 74-75.

10. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ejima et al. (U.S. Patent Application Pub. #2002/0021262).

As for **claim 7**, Ejima discloses a data recording and reproducing apparatus (figs. 1-6) having a function of recording audio data and image data associated with the audio data (page 1, paragraph 7), said apparatus comprising:

audio data recording means (fig. 4, ref. 12) for recording audio data (page 2, paragraph 39); and

imaging means (fig. 4, ref. 10) for recording image data (page 2, paragraphs 30-31) in association with a time elapsed (page 5, paragraphs 72-74). Also please see fig. 7 and read pages 4-5, paragraphs 62-71. However, Ejima does not expressly teach recording image data in association with a time elapsed during recording of the audio data, while the audio data recording means is recording the audio data. Examiner takes Official Notice that it is well known in the art to recording image data in association with a time elapsed during recording of the audio data, while the audio data recording means is recording the audio data. This modification enhances the operativity of a small-sized image/audio recording device.

***Note:** The Applicant's "*capable of*" language as used in the claims broadens the scope of the claims. The MPEP (2111.04 [R-3]) states that, "Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by language that does not limit a claim to a particular structure." In other words at the U.S. Patent and Trademark Office, if a limitation is written with "capable of" language, a reference is deemed to meet that limitation if the reference discusses the same element that, although not actually performing the claimed function, is **structurally capable of** performing it. Accordingly, the Examiner *will not* give a limitation with "capable of" language patentable weight.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Inoue et al. (U.S. Patent #6,226,449)	An apparatus including a recording and reproducing unit for a moving image signal, a recording and reproducing unit for a still image signal, a recording and reproducing unit for a digital speech signal operated in synchronous to the image.
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carramah J. Quiett whose telephone number is (571) 272-7316.

The examiner can normally be reached on 8:00-5:00 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NgocYen Vu can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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CJQ

June 9, 2006


NGOC YEN VU
SUPERVISORY PATENT EXAMINER